

<b>PETITION TO THE DIRECTOR UNDER 37 C.F.R. § 1.181</b>  Address to: Mail Stop Petition Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Attorney Docket No.	RICE-012
	Confirmation No.	8868
	First Named Inventor	DALY, ROGER J.
	Application Number	09/509,196
	Filing Date	March 23, 2000
	Group Art Unit	1649
	Examiner Name	CHERNYSHEV, O.
	Title: "A POTENTIAL EFFECTOR FOR THE GRB7 FAMILY OF SIGNALLING PROTEINS"	

Sir:

This petition is submitted to the Director of Patents and Trademarks under 37 C.F.R. § 1.181.

The Applicants hereby petition the Director of Patents and Trademarks to issue a second Examiner's Answer containing a New Ground of Rejection. Applicants request favorable consideration of this petition in view of the fact that, as detailed below, in the Examiner's Answer the Examiner (1) changed the statement and grounds of rejection for the rejection of Claims 5-7, 19-22, 24-29, and 31-41 under 35 U.S.C. § 101 from those used in the Final Rejection and (2) reintroduced issues in the Examiner's Answer which were not clearly used as basis for the Final Rejection.

Accordingly, Appellants respectfully request that this application be remanded to the Examiner for the issuance of a second Examiner's Answer including a New Ground of Rejection.

**(1) The statement and grounds of rejection for the rejection of Claims 5-7, 19-22, 24-29, and 31-41 under 35 U.S.C. § 101 were changed in the Examiner's Answer from those used in the Final Rejection**

In the Examiner's Answer, the Examiner changed the statement and grounds of rejection for the rejection of Claims 5-7, 19-22, 24-29, and 31-41 under 35 U.S.C. § 101 from those used in the Final Rejection, even though the statutory grounds, namely 35 U.S.C. § 101, for the rejection remained the same.

Specifically, under section (9) Grounds of Rejection of the Examiner's Answer, the Examiner stated the grounds for the rejection of Claims 5-7, 19-22, 24-29, and 31-41 under 35 U.S.C. § 101 as "the claimed invention is not supported by either a specific and substantial credible asserted utility or a well-established utility."

Answer at page 3 (emphasis added). **The facet of the rejection based on the alleged absence of a well-established utility was not set forth in the Final Rejection, and appeared for the first time in the Examiner's Answer.**

Moreover, while the new statement of rejection under § 101 refers to an unsupported well-established utility, the Examiner has not put forth in the Answer an explanation of lack of support for a well-established utility, as required by the Utility Guidelines. **As such, the rejection is not only a new ground of rejection, it is also an unexplained new ground of rejection.**

**(2) The Examiner's Answer introduced or reintroduced issues which were not clearly used as basis for the Final Rejection**

The Examiner's explanation of the rejection in section (9) of the Examiner's Answer differs in several respects from the explanation put forth in the Final Rejection. The Examiner resurrected additional issues in the Examiner's Answer. For example, the Examiner raised the orphan protein issue at page 3 and the issue of the candidate effector protein of yet undetermined function or biological significance at pages 4 and 5. These issues first appeared in a non-final Office action mailed April 2, 2001. However, **these issues were not specifically set forth as basis for the Final Rejection.** Rather, the Examiner made the Final Rejection

"essentially for reasons of record in appropriate sections of previous office actions of record." Answer at page 2 (emphasis added).

Accordingly, the actual specific basis for the outstanding final rejection under 35 U.S.C. § 101 were not made clear to Appellants until the Examiner's Answer. The Final Rejection did not state that the above issues formed the basis for the rejection. As such, these issues were not addressed in Appellants' Brief on Appeal.

Moreover, the Examiner asserted that "there is no evidence of record to show that 2.2412 polynucleotides are in fact differentially expressed in any tumors." Answer at page 6 (emphasis added). Prior to the Examiner's Answer, the Examiner's position was that such evidence had to be in the disclosure as filed. Now in the Examiner's Answer it appears the Examiner is implying that she will consider affidavit or other evidence, which Appellants are now precluded from submitting according to 37 C.F.R. § 41.41(a)(2). In addition, the Examiner's statement contradicts the record, which does in fact include evidence that 2.2412 polynucleotides are differentially expressed (see the Declaration of Yasumichi Hitoshi under 37 C.F.R. § 1.132, submitted February 4, 2003 (the "Hitoshi declaration"))).

Applicants submit that the facts and circumstances set forth above, as well as equity, call for the issuance of a second Examiner's Answer containing a new ground of rejection so that Applicants may respond fully and with all means available to them to the new grounds and issues raised for the first time in the Answer. Therefore, Applicants respectfully petition the Director to grant this petition and to issue a second Examiner's Answer containing a New Ground of Rejection.

Please charge the \$130.00 fee for filing this Petition to our credit card  
(USPTO Form 2038 is attached hereto).

The Director is hereby authorized to charge any underpayment of fees  
associated with this communication or credit any overpayment to Deposit Account  
No. 50-0815, order number RICE-012.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP



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